

**REMARKS**

At the time of the Office Action dated December 23, 2003, claims 1-20 were pending, all of which stand rejected.

In this Amendment, claims 1-20 have been amended. Care has been exercised to avoid the introduction of new matter. Specifically, claims 1, 3, 4, 6, 8, 17 and 18 have been amended to clarify who are offered a predetermined incentive. Adequate descriptive support for this amendment can be found on, for example, page 9, lines 20-27 of the specification.

**Foreign Priority.**

The Office Action acknowledges claim for foreign priority, but does not indicate receipt of the certified copy of the priority document (Japanese Patent Application No. 11-267258) filed on January 22, 2001. Applicants, therefore, respectfully request the Examiner to clarify the record by acknowledging the receipt of the certified copy of the priority document.

**Claim 3 has been rejected under 35 U.S.C. §112, second paragraph.**

The Examiner pointed out that the limitation “it” in line 13 of claim 3 does not have a clear antecedent basis. In response, Applicants have amended claim 3 to delete the limitation “it,” which obviates the reason for the rejection of §112, second paragraph. Accordingly, withdrawal of this rejection is respectfully solicited.

**Claims 1-20 have been rejected under 35 U.S.C. §102(e) as being anticipated by Robertson.**

In the statement of the rejection, the Examiner asserted that Robertson discloses a system and method for providing electronic multi-merchant gift registry services over a distributed network, identically corresponding to what is claimed.

It is established that the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Based on the above legal tenet, Applicants submit that Robertson does not disclose a network system including all the limitations recited in claim 1, as amended, within the meaning of 35 U.S.C. §102.

In Robertson's system, a gift registrant registers information for gifts and potential gift giver users can access the information. See the abstract. Specifically, Robertson discloses that the popularity of a particular item can be determined depending on how many users register the item. Based on popularity, a service provider offers special rates to entice customers to buy. See column 13, lines 5-34 (cited by the Examiner).

In response, Applicants specifically submit that Robertson does not disclose a network system including a server which comprises "incentive offering means for offering a predetermined incentive in regard to use of said predetermined service to only some of said terminals each of which has transmitted the request," recited in claim 1. Robertson does not disclose the above limitation specifying which terminals are eligible for receiving an incentive.

Robertson discloses, for example, that “an SP may register to be notified when 100 individuals register a particular item of interest,” “The SP may then use this list to perform marketing activities to those individual who did not opt out of agreeing to receive marketing information,” and “a SP site [may] use the marketing information to make highly popular items more visible on their site and offer special rates to entice customers to buy (column 13, lines 14-18 and lines 29-32, parts of the portions cited by the Examiner in this Office Action).

Based on Applicants’ review of Robertson above, it is, however, apparent that the reference does not disclose that the Service Provider 60 offers an incentive in regard to use of the service to only some of the user computers 50 which transmitted the requests to the Service Provider 60. Robertson merely discloses offering “special rates to entice customers to buy” (column 13, lines 29-32). Therefore, Robertson does not disclose a network system including all the limitations recited in claim 1 within the meaning of 35 U.S.C. §102.

Applicants note that the above arguments can be applied to other independent claims 3, 4, 6, 8, 16, 17 and 19 as those claims recite similar limitations to those of claim 1.

Accordingly, Applicant submits that Robertson does not disclose all the limitations recited in independent claims 1, 3, 4, 6, 8, 16, 17 and 19, and therefore, does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102. Therefore, Applicants respectfully solicit withdrawal of the rejection of those claims and favorable consideration thereof.

It is noted that a dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim.

Therefore, claims 2, 5, 7, 9-15, 18 and 20 are patentable because they respectively include all the limitations of independent claims 1, 4, 6, 8, 17 and 18. The Examiner's additional comments with respect to the claims do not cure the argued fundamental deficiencies of Robertson.

In addition, Applicants separately argue patentability of dependent claims 2, 12, 18 and 20. It is submitted that Robertson does not show "promotional information transmitting means for transmitting information for promoting requests for service together with information representing contents of the incentive to be offered..." recited in the claims. The Examiner's cited portion merely discloses that a trigger to send a notification to users can be changed, as shown in Fig. 26 (see column 21, lines 16-30). Therefore, the reference is silent on sending information for promoting a request for service with information representing a content of an incentive.

Further, Robertson does not disclose the limitation "said request count means counts terminals which have never requested the service before, when those terminals send the request to the server," as recited in the claim 9. The Examiner's cited portion merely discloses, for example, that "This information may include, for example the number of users that registered an item of interest" (column 13, lines 10-12). Robertson does not disclose how to count the number of users.

Moreover, Applicants note the Examiner's cited portions of Robertson are irrelevant to claims 5, 7, 10, 11, 13, 14

Based on the forgoing, Applicants respectfully solicit withdrawal of the rejection of claims 2, 5, 7, 9-15, 18 and 20 and favorable consideration thereof.

**Conclusion.**

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read "Tomoki Tanida", written over the printed name.

Tomoki Tanida

Recognition under 37 C.F.R. 10.9(b)

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